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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/483,175	01/13/00	XIA	C BRIGP001

021912 TM02/0328
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EXAMINER	
ROSSI, J	
ART UNIT	**PAPER NUMBER**
2165	

DATE MAILED: 03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/483,175	Applicant(s) XIA et al.
	Examiner Jeffrey Allen ROSSI	Group Art Unit 2165

☒ Responsive to communication(s) filed on *Jan 13, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-25* ~~is~~/are pending in the applicat

Of the above, claim(s) *none* ~~is~~/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-25* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *4*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

1. This action is responsive to the following communications: the application, filed 1-13-2000; and the IDS, filed 5-26-00.

2. The disposition of claims is as follows: claims 1-25 are pending in the application. Claims 1, 21, and 23-24 are independent.

3. The group art unit of the Examiner handling your case has probably changed. The new art unit is 2165. Please use the most up-to-date information on all correspondence to insure expedient correlation of all papers.

Background- Definitions

4. It is noted that the word "container" has a layman's definition and a more precise definition to **P**erson **H**aving **O**rdinary **S**kill **I**n **T**he **A**rt (*i.e.*, PHOSITA) in the technological arts, *e.g.*, document authoring. A container as generally referred to, in **OLE** terminology, is *a file containing linked or embedded objects* or as referred to in **SGML**, is *an element that has content as opposed to one consisting solely of the tag name and attributes* (from *Microsoft Press Computer Dictionary* © 1997 all rights reserved). It is further noted that **H**yper**T**ext **M**arkup

Language, *i.e.*, **HTML**; and eXtensible Markup Language, *i.e.*, **XML**; are both essentially derivatives of **SGML**. **HTML** was generally considered ubiquitous over the Internet at the time of the invention because it was easy to implement; while **XML** was and has been gaining popularity because of an increased functionality was able to handle more complex formatting and procedures. This background has been used as a guideline for interpreting "container" through the eyes of a person in the technological arts at the time of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

6. Claims 22 is rejected under 35 U.S.C. 102(e) as being anticipated by CRAGUN et al., US 6,161,112 **B1**, issued 12 DEC 00 .

7. Per independent claim 22, CRAGUN discloses:

defining the location and size of a marketing object container in the display medium (inherent, see element **610—FIG. 6**; associating a marketing attribute with the marketing

container ("presentation preferences"— **FIG. 11**), the marketing attribute including parameters that define how the marketing object container can be used in a marketing presentation (**FIG. 11**); binding at least one marketing object to the marketing object container ("The **HTML** code of the downloaded web page typically contains references to components that must be separately loaded"—col. 3, lines 45-50; **FIG. 6**; "Presentation item **128** is any portion of a web page that is presented to a user, whether by picture, audio, video, text or other means. Components in a web page such as graphical interface files {.GIF) and sound files {.WAV}, are examples of presentation items **128**"—col. 4, lines 20-25); and displaying the marketing object in the marketing object container in accordance with the parameters of the marketing attribute (**FIG. 6**).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-2, 8-9, 12-15, 19, and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by WONG et al., US 5,890,175 **B1**, issued 03-30-1999; in the alternative, under 35

U.S.C. 103(a) as obvious over WONG et al., US 5,890,175 **B1**, issued 03-30-1999 in view of the Screen-shot of JPG file attributes taken from WINDOWS NT (c) 1998 MICROSOFT Corp. (c) 1998 taken 21 MAR 01.

10. Per independent claim 1, WONG diploses a method of providing an electronic marketing presentation (*e.g.*, **FIG. 5**), comprising: displaying a marketing object container (*e.g.*, Product Picture Name"—**82**; associating an attribute with the marketing object container (*inherent* in "multimedia objects, such as graphics images, audio clips, video clips and program applets into the merchant store"—col. 3, line 67 et *seq.*; explicitly in "Mark box ☒ if this product will include a picture in its description page"—**FIG. 8**); ; and selecting at least one marketing object for being associated with the marketing object container, *e.g.*, PICTURE6 (**FIG. 5**). The Examiner is aware that the WONG reference does not employ the term "attribute". However, it explicitly recites **HTML** authoring and the insertion of multimedia objects which inherently have user definable attributes. —A reference must disclose the claimed subject matter either *expressly* or *inherently*— *Constant v. Advanced Microwave Devices, Inc.*, 7 USPQ2d 1057 (Fed. Cir. 1988). —A reference which is silent about a claimed invention's features is inherently anticipatory if the missing feature is necessarily present in that which is described in the reference. Inherency is not established by probabilities or possibilities—.*In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999). —Inherency requires inevitable presence—. *In re Oelrich*, 212 USPQ 323 (CCPA 1981). While there were conceivably multimedia objects without user definable attributes, it would have been *impossible* for this invention to operate as described if only objects without user-definable

attributes were present. Examples of well-known object attributes were "file type" and, "read only", "archive" and "compresses" for JPEG image files, although image objects inherently had multitudinous file types defined by the user. Therefore, WONG is anticipatory. Should Applicant disagree, it would have been obvious to PHOSITA at the time of the invention to include attributes in the multimedia objects of WONG in order to insure compatibility with existing objects.

11. Per independent claims 23-24, these claims are directed to a system and computer product corresponding the method of independent claim 1, supra, and thus are identically rejected.

12. Per dependent claim 25(24)WONG explicitly discloses claimed system memory 6. It is noted that dependent claim 25 recites a *Markush* group. -*See Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). It is noted that CD-ROM, floppy disk, take, flash, system memory and data signal embodied in a carrier wave were all recognized as interchangeable means of transporting and storing a computer program.

13. Per dependent claim 2, WONG discloses claimed "container icon", element **72**— **FIG. 7**.

14. Per dependent claim 8 (1); claimed selecting a style is taught by the recitation: "the same product information can be presented in different manners depending on the selection of *[a]* display template"—col. 6, lines 40-45; See also element 41—**FIG. 4**.

15. Per dependent claims 9 (1) and 12(9); WONG further discloses associating a feature wit an object container (element **43**—**FIG. 4**; See also "product description"—element **52**—**FIG. 5**; See also keywords—**FIG. 8**; See also "Promotional Sale Information"—**FIG. 8**).

16. Per dependent claim 13(9); the rejection of this claim is substantially identical to the rejection of dependent claim 9, *supra*, noting that the marketing "object" corresponds to the object displayed by *e.g.*, PICTURE 6—**FIG. 8**.

17. Per dependent claim 14(1) and 15(1); the marketing object of WONG is dynamically associated (ABSTRACT). It is noted that the breadth of these claims does not require the object in a given container of the template to be dynamically changed, only dynamically bound. In the interest of "compact prosecution" it is noted, nonetheless, that it was notoriously well-known to dynamically bind rotating advertisements to object containers. It would have been obvious to PHOSITA to rotate marketing objects in its containers in order to change display ads according to user preferences and environment.

18. Per dependent claim 19 (1) WONG demonstrates displaying, *e.g.*, PICTURE 6, after the user has entered it into form. Approval of PICTURE 6 is inherent, because the author would not enter the information if he did not approve of it for display.

19. Claims 3-7 are rejected under 35 U.S.C. 102(e) as being anticipated by WONG et al., US 5,890,175 **B1**, issued 03-30-1999 of (noting the Screen-shot of JPG file attributes taken from WINDOWS NT (c) 1998 MICROSOFT Corp. (c) 1998 taken 21 MAR 01 as evidence of Inherency of attributes in object); in the alternative, under 35 U.S.C. 103(a) as obvious over WONG et al., US 5,890,175 **B1**, issued 03-30-1999 in view of CRAGUN et al., US 6,161,112 **B1**, issued 12 DEC 00 .

20. Per dependent claim 3, it is believed that the process of presenting a screen of attributes for association with the object is inherent in WONG. As demonstrated by the screen-shot of WINDOWS NT provided, the process of associating multiple attributes with multimedia images was *inherent* because WONG would have been partially inoperable for its intended purpose if it were not compatible with existing JPG technologies. However, in anticipation of Applicant's disputing the *inherency* of selecting attributes for association with the template objects of WONG, it is noted that CRAGUN explicitly discloses editing of multiple attributes associated with advertisement, *i.e.*, claimed marketing, objects (See the ABSTRACT, **FIG. 16**, element **1410-1450—FIG. 14**; **FIG. 11.** It would have been obvious to PHOSITA at the time of the invention to include an attribute editing screen with multiple attributes as taught by example in **FIG. 11** of CRAGUN in order to increase the flexibility of the authoring system of WONG to include more display preferences.

21. Per dependent claim 4(1); this claim is identically rejected to dependent claim 5. The compatibility of the plurality of attributes presented is implicit in both the WONG reference and the CRAGUN reference, therefore the reason for combination is identical to that set forth, *supra.*

22. Per dependent claims 5(1)-6(1); the "display template" described by WONG (col. 6, lines 40) is *de facto* the claimed "style template". This is further evidenced by the observation that "the same product information can be presented in different manners, depending on the selection of {a} display template"—col. 6, lines 40-45. The act of filling in the object is inherent in the rendering of the presentation page (*e.g.*, **FIG. 15**)

23. Per dependent claim 7(1), it is noted that the language "associating an item with said attribute" is very broad. Therefore, the presentation preferences associated with the attributes in WONG and CRAGUN (as combined in detail the rejection of dependent claim 3, supra, hereby incorporated by reference), meets this limitation (see **FIG. 11** and all elements **1610-1646—FIG. 16**).

24. Claims 10-11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WONG et al., US 5,890,175 **B1**, in view of HENSON, US 6,167,383 **B1**..

25. Per dependent claims 10-11; WONG lacks associating a "cross-sell" and "up-sell" feature with its marketing objects. HENSON. on the other hand, demonstrates dynamically associating a banner object **100** (abstract, col. 9, lines 40-55) wherein an "up-sell" or "cross-sell" feature was associated with the object (col. 9, lines 43-44). It would have been obvious to PHOSITA at the time of the invention to combine HENSON with WONG by providing a "cross-sell" or "up-sell" feature with at least one of the marketing containers of WONG in order to bind cross-sell and up-sell objects into the template of WONG in a manner disclosed by HENSON. Furthermore, this would have provided the benefit of increasing likelihood of selling more merchandise in the catalogue system of WONG in a manner disclosed by HENSON.

26. Per dependent claim 20(1); WONG lacks an explicit recitation of an association of an object of a marketing container based on an object of a first object container, although it id implied, for example, by the objects which are associated in element **52—FIG. 5**, were all

probably "associated" by the author. HENSON, on the other hand, explicitly demonstrates associating marketing objects with other marketing objects (col. 9, lines 40-45 wherein marketing objects are associated with "cross-sell" and "up-sell". It would have been obvious to PHOSITA at the time of the invention to combine the container association of HENSON in the template of WONG in order to create up-sell and cross-sell opportunities in the web pages of WONG.

27. Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by WONG et al., US 5,890,175 **B1**, issued 03-30-1999 of (noting the Screen-shot of JPG file attributes taken from *WINDOWS NT* (c) 1998 MICROSOFT Corp. (c) 1998 taken 21 MAR 01 as evidence of Inherency); in the alternative, under 35 U.S.C. 103(a) as obvious over WONG et al., US 5,890,175 **B1**, issued 03-30-1999 in view of KURTZMANN, II et al., US 6,144,944 **B1**, issued 11/00.

28. Per dependent claim 16(1); WONG lacks a demonstration of its object being selected from a plurality of associated objects based on an attribute associated with a marketing container. KURTZMAN II, on the other hand, demonstrates that it was well-known to associate an "affinity attribute" (col. 4, lines 17, 32-35, and 40-45) with an object container "... dynamic HTML, images..."—col. 2, lines 55-56. It would have been obvious to PHOSITA at the time of the invention to include the affinity engine of KURTZMAN II un the template of WONG in order to generate advertisement of interest in WONG

29.Per dependent claim 17(16), rotating adds according to a schedule was notoriously well-known as demonstrated by KURTZMAN II (col. 5, lines 5, lines 5-7). It would have been obvious to PHOSITA at the time of the invention to rotate adds according to a schedule in WONG and KURTZMANN II in order to give a uniform exposure, for example, to ads from a given sponsor (col. 4, lines 40-45).

30. Per dependent claim 18(16); KURTZMANN II demonstrates distributing an add based on another marketing object ("These advertisements correspond to sponsor's ads for that specific page"—col. 4, lines 40-45; and key word sponsor engine—col. 4, lines 45-50. It would have been obvious to PHOSITA to include KURTZMANN II in WONG in order to maximize relevance of a display ad (col. 4, lines 26-31 of KURTZMANN II).

31. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over COLLINS-RECTOR et al., US 6,188,398 B1, issued 02/2001; in view of RUTTENBERG et al., WO 99/62013 published 12/1999[1] .

32. Per independent claim 22; COLLINS-RECTOR discloses displaying a marketing object container **33—FIG. 2** on a display medium; in response to a selection of the marketing object container 19 (**FIG 1**) creating a campaign associated with the object container ("select campaigns from the left side menu"—col. 4, lines 25-35. It lacks the process of selecting a campaign from a plurality of campaigns displayed and selecting an offer associated with the campaign, although it is suggested that an URLS corresponding to an offer is selected (col. 3, lines 60-65).

RUTTENBERG et tal., on the other hand, explicitly discloses a container, i.e., banner, wherein a wherein a campaign attribute is associated with the container from a plurality of campaigns (page 6, lines 1-7), and at least one offer is associated with the campaign (inherent, as described via example by "any consumer who reads the advertisement...orders the 6 coca-cola bottles"—col. 8, lines 11-17. It would have been obvious to PHOSITA at the time of the invention to associate campaigns attributes with the containers of COLLINS-RECTOR in order to provide multiple remuneration terms as associated with a container as taught by RUTTENBERG. "Official Notice" is hereby taken that tit was notoriously well-known to associate multiple ads with a given campaign. It would have been obvious to PHOSITA at the time of the invention to choose from multiple offers associated with the campaigns of **COLLINS-RECTOR** and **RUTTENBERG** in order to allow for a wider choice of the advertiser in order to better adapt ti its advertising venue.

1. Note: New law allows use of international filing date as effective date of prior art

Citation of Prior-Art

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,860,073 B1 (FERREL et al.)	ABS, SUMMARY
US 5,873,068 B1 (BEAUMONT et al.)	col. 2, lines 5-15.
US 5,907,837 B1 (FERREL et al.)	ABS, SUMMARY
US 5,991,735 B1 (GERACE)	ABSTRACT
US 6,009,410 B1(LEMOLE et al.)	ABS FIGS 2-4
US 6,026,368 B1 (BROWN et al.)	ABSTRACT
US 6,029,195 B1 (HERTZ)	col. 6, lines 45-50
US 6,061,057 B1 (KNOWLTON et al.)	SUMMARY, col. 3, line 26 et seq.
US 6,157,926 B1 (APPLEMAN et al.)	FIGURES
US 6,161,114 B1 (KING et al.)	ABSTRACT
US 6,182,050 B1 (BALLARD)	ABSTRACT
US 6,199,106 B1 (SHAW et al.)	ABSTRACT

FOREIGN

WO 01/01686 (WEBTV)	ABSTRACT, BACKGROUND, SUMMARY
WO 01/08052 (ON-LINE DESIGN, INC)	ABSTRACT

NPL

MCDERMOTT, Dan.. "Pageflex, Inc. Introduces WebForm WizardTM for the PageflexTM Mpower Application Suite"

Conclusion

Any response to this action should be mailed to:

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Washington, D.C. 20231

or faxed to

(703)-308-9051 (**formal** communications intended for entry)

Or:

(703)-305-9724 (**informal** communications labeled **PROPOSED** or **DRAFT**)

Hand-delivered responses should be brought to:

Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey ROSSI whose telephone number is (703) 308-5213 . The examiner can normally be reached on Monday - Friday from 0830 to 1630 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vinnnie MILLIN, can be reached on (703) 305-9703.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1065.

JAR

2001-03-22

VINCENT MILLIN
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